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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,226	09/02/2004	Burton G. Goldstein	1372.189.PRC	5225
21901	7590	11/06/2006	EXAMINER	
SMITH HOPEN, PA 180 PINE AVENUE NORTH OLDSMAR, FL 34677			LANG, AMY T	
			ART UNIT	PAPER NUMBER

1714

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/711,226	GOLDSTEIN, BURTON G.	
	Examiner	Art Unit	
	Amy T. Lang	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 September 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: element 28 disclosed in line 1 of paragraph 35. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities:

(i) Line 6 of paragraph 7 includes the phrase " removing large or very bodies," which should be replaced with "large or very large bodies."

(ii) Line 4 of paragraph 34 includes "tool.10," which should be replaced with "tool 10."

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Peterson (US 5,891,153).

Peterson discloses an instrument to remove objects from the eye (column 1, lines 4-6). This instrument is comprised of a tubular member (4) and a shaft (2) disposed within the tubular member (column 6, lines 22-28; Fig. 1). These two components are in open communication and clearly overlap the instantly claimed elongate base and elongate bore. A control knob (1) is located at the proximal end of the instrument and an expandable wire basket is located at the distal end of the instrument (column 6, lines 27-28; column 7, lines 8-10).

The disclosed control knob is initially fully extended while the net is retracted within the tubular member (see Fig. 4). When the control knob is pushed into the instrument, the net basket is then advanced through the tubular member until it reaches its fully extended position (column 7, lines 28-37). Therefore, an infinite number of adjustment positions are present on the control knob.

Once the net is fully extended within the eye, it is used to capture the fragments (column 9, lines 24-27). The net is then retracted back into the tubular member, due to the control knob, with the fragments (column 9, lines 39-47).

The disclosed net is a basket-like shape, when fully extended and contracted (see Fig. 6). It consists of a rim of wires and a flexible netting (column 7, lines 8-26).

Therefore, Peterson '153 anticipates the cited present claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sabet (US 2003/0135221 A1).

Sabet discloses an instrument to remove fragments from the eye ([0013]). This instrument is comprised of a sleeve and handle, an operating member, and a net ([0021]).

Fig. 1 of Sabet discloses a handle (14) and sleeve (25), extending from the handle, which together comprise the instantly claimed elongate base ([0039]). The operating member (19) is disposed within the sleeve so that the sleeve and operating member are in open communication ([0039]). Therefore, the sleeve comprises an elongate bore. Furthermore, the operating member is able to slide within the sleeve due to the sliding movement of the actuator (26) relative to the handgrip ([0039]). This is accomplished by a longitudinal slot (33), on which the actuator is located, that runs parallel to the movement of the net. Correspondingly, the net (12) also moves with the movement of the actuator ([0039]). A pin (31) connects the actuator to the handle of the instrument, which clearly overlaps the instantly claimed rigid rod ([0039]).

The net is attached to and initially retracted in the sleeve ([0020]). Once the end of the sleeve has entered the eye, the actuator is moved causing the net to proceed outward so that the rim opens and the net is fully contracted (see for example Fig. 5). The net is then utilized to capture the fragments and then collapsed and retracted into the sleeve ([0045]).

Sabet discloses the net as comprised of a mesh or netting material and a biocompatible metal rim, which encompasses a metallic or polymeric material ([0036], [0037]). Two arms (16a and 16b) comprise the metal rim so that they extended outwardly from a common place and converge and cooperate to form the disclosed rim ([0036]).

Sabet does not specifically disclose (i) an infinite number of adjustment positions of the actuator, (ii) the slot length equal to elongate bore and slot width less than

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elongate bore, (iii) truncate slot in bottom wall of base, and (iv) an elliptical shaped rim and basket-like net.

With respect to (i) above, Sabet discloses that the actuator is adjusted due to the sliding motion within the longitudinal slot. Therefore, although Sabet does not explicitly disclose an infinite number of sliding positions, it would be obvious to produce such an adjustment since a sliding mechanism is utilized.

With respect to (ii) above, although Sabet does not specifically disclose the size of the slot relative to the elongate bore, Fig. 1 indicates that the slot length is not equal to the bore and the slot width is greater than the elongate bore. However, it would have been obvious to change the size of the slot, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art (*In re Rose*, 105 USPQ 237 (CCPA 1955)).

With respect to (iii) above, since the actuator slides across the handle within a slot, it would have been obvious for another slot to be placed in the bottom wall of base. A sliding motion such as the one disclosed by Sabet, consists of an actuator placed within a slot so that it is able to move forward and backward. Therefore, by placing another slot along the bottom wall base, the same function is accomplished. It has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art (*In re Karlson*, 136 USPQ 184). It therefore would have been obvious to one of

ordinary skill in the art to also include a truncate slot in bottom wall of base of the actuator sliding mechanism.

With respect to (iv) above, Sabet discloses a second instrument to remove fragments from the eye. This instrument also includes a handle and net to enclose the fragments (see Fig. 7). This net is curved to adopt a spherical configuration, which encompasses an elliptical, to correspond to the curvature of the posterior capsular wall of the anatomical lens ([0050]). Therefore, since an elliptical shape is more compatible with the anatomical lens, it would have been obvious for the net of the first instrument to also be of an elliptical shape.

8. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson (US 5,891,153) in view of Sabet (US 2003/0135221 A1).

Peterson, as discussed in paragraph 4 and incorporated here by reference, discloses a surgical instrument for removing fragments from the eye. The instrument is comprised of an elongate base and net for capturing such fragments, wherein the net consists of a wire rim.

Peterson does not specifically disclose the netting as a fabric mesh or the wire rim as being formed of a metallic or polymeric material.

Sabet, as discussed in paragraph 7 and incorporated here by reference, also discloses surgical instruments for removing fragments from the eye. One such instrument comprises an elongate base and a net for capturing such fragments (see Fig. 7). The net is also comprised of a wire rim of a biocompatible metal, which

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encompasses a metallic or polymeric material ([0036]). The net is a biocompatible plastic material, which encompasses a fabric mesh ([0037]). Therefore, Sabet discloses a net for removing fragments in eye that is comprised of a fabric mesh and either a metallic material or polymeric material. This surgical device that utilizes the disclosed net and rim is taught as safer for patients undergoing surgery.

Both Peterson and Sabet disclose a surgical instrument comprised of a net and rim utilized to remove fragments in an eye for surgical procedures. The specific instrument of Sabet are taught as safe for patients, so that it would have been obvious for Peterson to also utilize the fabric mesh net and metallic or polymeric rim disclosed by Sabet.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy T. Lang whose telephone number is 571-272-9057. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ~~Vasu Jagannathan~~ ^{ANH TUAN NGUYEN} ⁴⁹⁶³ can be reached on 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

11/01/2006

ATL


ANH TUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER

11/3/06.